

### **REMARKS**

Reconsideration and withdrawal of the rejections of this application are respectfully requested in view of the remarks and amendments herewith.

Claims 1 and 3-29 are pending in the subject application. Claims 2 and 30-40 are withdrawn. Applicants have amended claims 1 and 19 of the subject application without prejudice.

No new matter is added.

#### **I REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claims 1, 3-24 and 26-29 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleges that it is not clear if  $R^7$  and  $R^9$  in the definition of  $R^{12}$  of claim 1 can form a ring in the moieties including  $-NR^7C(O)R^9$  and  $-NR^7SO_2R^9$ . *Office Action* at 3. In addition, claim 19 stands rejected under U.S.C. § 112, second paragraph for informalities. Applicants have amended the claims to overcome the rejections.

In view of these amendments, Applicants respectfully request reconsideration and withdrawal of the § 112, second paragraph rejection.

#### **II. REJECTION UNDER 35 U.S.C. §103**

Claims 1 and 3-23 stand rejected as allegedly obvious under 35 U.S.C. § 103 over Sobolov-Jaynes et al. (US 6,255,318) ("Sobolov") in view of Beree et al. (Syn. Comm., 29(15), 2685-2693 (1999)) ("Beree"). Applicants respectfully traverse the rejections.

Applicants respectfully submit that Sobolov does not qualify as prior art to the instant application under 35 U.S.C. §103(c). Specifically, at the time the instant invention was made, the instant invention was owned by or subject to an obligation of assignment to Pfizer Inc. and SOBOLOV was owned by or subject to an obligation of assignment to Pfizer Inc.

Accordingly, Sobolov cannot be applied against the instant application in a 35 U.S.C. § 103(a) rejection because of the exemption provided for commonly owned reference 35 U.S.C. §103(c).

In view of the above, Applicants' respectfully request the Examiner to reconsider and withdraw the application of the 35 U.S.C. § 103(a) rejection based upon Sobolov.

In addition, claims 24-29 stand rejected as allegedly obvious under 35 U.S.C. § 103 over Beree in view of March (Advanced Organic Chemistry (1992) ("March"). Applicants respectfully traverse the rejections.

Establishment of *prima facie* obviousness requires three conditions. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim elements.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the Examiner has failed to point to any disclosure, teaching or suggestion in Beree or March to make the compounds of formula I as recited in claim 1 of the instant application. The Examiner merely recites bits and pieces from Beree and March using Applicants' disclosure as the blue print to arrive at the claimed invention. This is improper.

The Examiner alleges that Beree or March generically teaches processes for deprotecting and acylating an amine of any structure or size. But claims 24-29 depend, directly or indirectly, on claim 1 and thus include all the elements of claim 1. The Examiner does not provide any disclosure, teaching, suggestion or motivation in Beree or March to suggest a method for preparing compounds of formula I as recited in claim 1.

Based on the arguments and submissions presented above, which show that the requirements for *prima facie* obviousness have not been satisfied, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

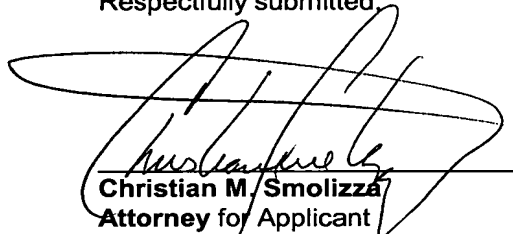
#### **CONCLUSION**

In view of the remarks and amendments, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

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Respectfully submitted,

  
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